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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DUSTIN C. KIRKLAND and LILIANA OROZCO

Appeal 2009-002027
Application 10/660,013¹
Technology Center 2100

Before JOHN A. JEFFERY, JAY P. LUCAS, and JAMES R. HUGHES,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL²

¹ Application filed September 11, 2003. The real party in interest is International Business Machines Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 to 15 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' invention relates to a method of searching web pages within a website (Spec. 5, top). In the words of Appellants:

[A] search may be as follows:
[http://www.abc.com\[tool expense\]](http://www.abc.com[tool expense]). The following [uniform resource locator] in a table of contents would be considered a match: <https://www-1.abc.com/tools\view\expenses\index.shtml>. As can be seen, the term[s] tool and expense are found within this [uniform resource identifier (URI)]. As described above, these matches are with respect to the URIs and not to content in the Web page itself.

(Spec. 14, top to middle).

The following claim illustrates the claims on appeal:

Claim 1:

1. A method in a data processing system for searching for Web pages within a Web site, the method comprising:

receiving a search statement as a result of a user input, wherein the search statement includes a universal resource identifier and a regular expression;

retrieving universal resource identifiers associated with the universal resource identifier in the request to form retrieved universal resource identifiers;

parsing the retrieved universal resource identifiers for the regular expression to form search results; and

returning the search results, wherein the search results include a list of universal resource identifiers associated with the Web pages within the Web site.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Schneider US 7,136,932 B1 Nov. 14, 2006
(filed Mar. 21, 2000)

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1 to 15 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Schneider.

R2³: Claim 14 stands rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

³ Claim 14 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter (Non-Final Rej. mailed March 9, 2007, pp. 2 to 4). The Examiner maintained the rejection in the Final Office Action mailed August 10, 2007 (p. 2). Although the Examiner's Answer makes no mention of the rejection of claim 14 under 35 U.S.C. § 101 (*see* p. 3, bottom), Appellants concede that the claim is directed to non-statutory subject matter (App. Br. 9, middle). Appellants' acknowledgement is effective waiver of

R3⁴: Claims 8 to 13 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

We will review the rejections in the order argued, and as grouped in the Briefs. We have only considered those arguments that Appellants actually raised in the Briefs. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

The issues involve whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. §§ 101 and 102(e). The issue under 35 U.S.C. § 102(e) specifically turns on whether the Schneider reference teaches Appellants' claimed steps of "receiving a search statement ... [that] ... includes a universal resource identifier and a regular expression" (claim 1) and "parsing the retrieved universal resource identifiers for the regular expression" (claim 1). The issue under 35 U.S.C. § 101 turns on whether Appellants disclose structures corresponding to the "means for" language recited in claim 8.

their right to appeal. Notice of Appeal is an appeal of all of the claims pending in the patent application. (*See* 37 C.F.R. § 41.31(c).) Accordingly, we affirm the Examiner's rejection of claim 14 under 35 U.S.C. § 101.

⁴ The Examiner raised a new ground of rejection for claims 8 to 13 (Ans. 4).

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Disclosure

1. Appellants have invented a method, apparatus, and computer program for searching web pages within a website (Spec. 1, top.). Appellants' method includes parsing universal resource identifiers for a regular expression (claim 1). Appellants' disclosure states that "in [a] search, the [regular] expression is used as a search term to determine whether this term is present" within a series of universal resource identifiers in a table of contents (Spec. 14). Regular expressions are defined as "matches ... with respect to the [universal resource identifiers] and not to content in the Web page itself." (*Id.*).

Schneider

2. The Schneider reference teaches searching for web pages within a website. (*See* Fig. 13 and col. 30, l. 25.) Schneider's method involves searching for character strings in the universal resource identifiers associated with the web pages (*id.*). Schneider teaches retrieving "[Uniform Resource Identifier or URI] generations" based on a user's input (col. 17, ll. 35 to 44; col. 30, ll. 22 to 26 and 37 to 45). Schneider further teaches that regular expressions (*e.g.*, "company" as shown in Fig. 13) are matches with respect to the universal resource identifiers. (*See* Fig. 13.)

PRINCIPLE OF LAW

Appellants have the burden on appeal to the Board to demonstrate Examiner error. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

ANALYSIS

*Arguments with respect to the rejection
of claims 1 to 15
under 35 U.S.C. § 102(e) [R1]*

The Examiner rejected the noted claims as being anticipated by the Schneider reference, pages 5 to 10.

Appellants argue:

“Nowhere does [Schneider’s column 18] teach or even suggest the feature of ‘receiving a search statement as a result of a user input, wherein the search statement includes a universal resource identifier and a regular expression.’ Rather Schneider teaches that the input is either a domain name or IP address or search request, but not both.”

(App. Br. 13, middle).

The Examiner replies that the “receiving” step is taught in Figure 13 and at column 30, line 25 of Schneider.

We find unconvincing Appellants’ argument that the claimed step of “receiving a search statement … [that] … includes a universal resource identifier and a regular expression” is not met. We disagree because Appellants’ argument incorrectly posits that the claimed “search statement” must be read on Schneider’s “input 210 [that] may include either an IP address or a domain name” (Schneider, col. 18, ll. 46-47; App. Br. 12, middle). We find that Appellants’ claimed “search statement” reads on “URI generations” in Schneider. The cited portion of the patent shows that when a user of Schneider’s system inputs a search term (e.g., “company,” as cited by the Examiner for the claimed “regular expression”), “URI generations” that include the term “company” are output (Appellants’

claimed “receiving” step) to the user (FF#2). The “URI generations” created for the user are the same as Appellants’ claimed “search statement.” Thus, Appellants have not demonstrated error in the rejection R1 in this regard.

Next, Appellants argue that none of the cited portions of Schneider teach the “parsing … for the regular expression,” as required by claim 1 (App. Br. 16, middle). The Examiner finds that the “parsing” step of claim 1 is taught in column 30 at lines 30 to 42 of Schneider (Ans. 6, top).

We disagree with Appellants for the following reasons. Appellants do not limit what “parsing” means, includes, or represents (Spec. 1 to 19).

Reading the claim language broadly but reasonably, *see In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989), we interpret the claimed “parsing” step as reading on a search for character strings in the URI’s of web pages. (See Spec. 5, top to middle.) Since Schneider teaches searching (Appellants’ claimed “parsing”) of universal resource identifiers containing search terms entered as user input (Appellants’ claimed “regular expressions”), we find Appellants’ “parsing” step is met by the reference.

Appellants contend that since Schneider is directed to domain name aliasing, the reference necessarily fails to teach the claimed “retrieving” and “parsing” steps of claim 1 (App. Br. 16, middle to bottom).

We find unconvincing Appellants’ argument. Whether Schneider solves the same problem in the document search-and-retrieval arts as the claimed invention is not the issue. Rather, the test for anticipation is whether all of the claim limitations are met by the reference. (*See Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (holding that in rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that

discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.”

For all of the above-stated reasons, Schneider fully anticipates Appellants’ claim 1. Accordingly, we find Appellants have not demonstrated error in the rejection R1.

In accordance with 37 C.F.R. § 41.37(c)(1)(vii), Appellants made separate arguments concerning claim 15 (App. Br. 18, middle). Appellants argue that Schneider fails to teach “sending a request … to retrieve a table of contents [that] comprises universal resource identifiers associated with the universal resource identifier in the received request,” as required by claim 15 (App. Br. 18, middle). However, upon review of Schneider’s teachings, we adopt and endorse the Examiner’s findings regarding claim 15. We refer Appellants to the “Response to Arguments” section of the Answer for further details (Ans. 13, bottom to 14, middle).

*Arguments with respect to the rejection
of claims 8 to 13
under 35 U.S.C. § 101 [R3]*

The Examiner added a new ground of rejection under 35 U.S.C. § 101 of claims 8 to 13. The Examiner rejected the claims as software *per se*. Appellants respond for the first time to the new ground in the Reply Brief (Rep. Br. 1 to 3), arguing that at least one hardware structure corresponds to each means recited in claim 8 (*id.* at 2, top to middle). We agree with Appellants’ argument that sufficient structure corresponding to the “means for” claim is disclosed in the Specification. Accordingly, we reverse the rejection R2 of claims 8 to 13.

In contradistinction, we note that we affirm the rejection R2 of claim 14 because Appellants failed to argue for the claim. (*See* footnote *supra*.)

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in the anticipation rejection R1 of claims 1 to 15. Since Appellants opted not to argue the 35 U.S.C. § 101 rejection R2 of claim 14, we conclude that Appellants have not demonstrated Examiner error. Appellants have demonstrated error in the 35 U.S.C. § 101 rejection R3 of claims 8 to 13.

DECISION

We affirm the Examiner's anticipation rejection R1 of claims 1 to 15. We affirm the 35 U.S.C. § 101 rejection R2 of claim 14. We reverse the Examiner's 35 U.S.C. § 101 rejection R3 of claims 8 to 13.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

peb

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